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Mailed: July 25, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re BEE FLY SARL

Serial No. 76365771

David M. Carter of Carter Schnedler & Monteith for BEE FLY SARL.

Giancarlo Castro, Trademark Examining Attorney, Law Office 110 (Chris A.F. Pedersen, Managing Attorney).

Before Walters, Drost and Zervas, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

BEE FLY SARL has filed an application to register the mark STAR FLY on the Principal Register for "non-intimate footwear, namely, shoes, sport shoes, sandals, boots, ankle boots, moccasins, clogs, loafers, plain pumps and shoes with wedge outsoles; and non-intimate clothing, namely, t-shirts."¹

¹ Serial No. 76365771, in International Class 25, filed February 1, 2002, based on an allegation of a bona fide intention to use the mark in commerce.

The Trademark Examining Attorney has issued a final refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark STARFLY, previously registered for "intimate apparel, namely, nightshirts, pajamas, underwear, socks, robes, slippers, boxer shorts, nightcaps, fleece loungers, bras,"² that, if used on or in connection with applicant's goods, it would be likely to cause confusion or mistake or to deceive.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

The examining attorney contends that the marks are virtually identical; that the respective goods "are related clothing items that could reasonably be sold by the same entity in a line of such clothing products" (brief, p. 2); that applicant's goods are within registrant's logical zone of expansion, as evidenced by third-party registrations made of record by the examining attorney that include both applicant's and registrant's goods in a single registration; and that lack of evidence of actual confusion is of little value in an ex parte proceeding.

² Registration No. 2730171 issued June 24, 2003, to Creative Apparel Concepts, Inc., in International Class 25.

Applicant contends that the respective goods are different because applicant's shoes and clothing items are non-intimate apparel, whereas registrant's clothing items are intimate apparel; that the trade channels for the respective goods are different because there are large chain stores that specialize in intimate apparel, intimate apparel is not sold at shoe or t-shirt stores or in the "shoe or t-shirt department[s] of a store where applicant's goods would be found" (brief, p. 3); that registrant's mark is not famous, "thus lessening the likelihood of confusion with applicant's mark" (id.); that there is no evidence of actual confusion; and that even "identical marks have been held not likely to be confused" (brief, p. 4).

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d

1098, 192 USPQ 24, 29 (CCPA 1976); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein. The factors deemed pertinent in this proceeding are discussed below.

Applicant's mark is virtually identical to the mark in the cited registration, and applicant does not contend otherwise. The registered mark consists of two words telescoped into a single word, STARFLY; and applicant's mark consists of the same two words simply separated by a space, STAR FLY. It is a well-established principle that the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Clearly, the minor spacing difference between these two marks is insignificant.

It is also well established that when the marks at issue are the same or nearly so, the goods in question do not have to be closely related to find that confusion is

likely. As we stated in *In re Concordia International Forwarding Corp.*, 222 USPQ 352, 356 (TTAB 1983), ". . . the greater the degree of similarity in the marks, the lesser the degree of similarity that is required of the products or services on which they are being used in order to support a holding of likelihood of confusion." It is sufficient that the goods are related in some manner and that their character or the circumstances surrounding their marketing are such that they are likely to be encountered by the same people in situations that would give rise to the mistaken belief that the producer was the same. *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). The question is not whether purchasers can differentiate the goods themselves but rather whether purchasers are likely to confuse the source of the goods. *See Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989).

Each of the six third-party registrations submitted by the examining attorney contains a number of the clothing and footwear items identified in both the application and the cited registration. Although third-party registrations which cover a number of differing goods and/or services, and which are based on use in commerce, are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, these registrations

nevertheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988).

Moreover, in this case, we note that applicant's t-shirts are closely related to registrant's nightshirts and may be interchangeable in use; and registrant's identification of goods includes footwear items, i.e., slippers.

We conclude that in view of the virtually identical commercial impressions of applicant's mark, STAR FLY, and registrant's mark, STARFLY, the clothing and footwear products involved in this case are sufficiently related that the contemporaneous use of applicant's and registrant's marks thereon is likely to cause confusion as to the source or sponsorship of such goods.

We find applicant's arguments to the contrary to be unpersuasive. First, regarding the channels of trade of the respective goods, both the application and the cited registration are broadly worded so that we must presume that the goods of applicant and registrant are sold in all of the normal channels of trade to all of the usual purchasers for such goods. See *Canadian Imperial Bank v. Wells Fargo*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). That is, we must presume that the goods of applicant and registrant are sold

through the same channels of trade to the same classes of purchasers.

Applicant's argument regarding lack of fame is irrelevant in this case. The fame of the registered mark has not been asserted and the lack thereof does not limit the strength of or scope of protection to be accorded this apparently arbitrary mark.

Regarding applicant's allegation of lack of actual confusion, this factor is of little significance in an ex parte situation where the registrant has not had an opportunity to present evidence. Further, because this application is based on a bona fide intention to use the mark in commerce and the record contains no evidence of use, it is unlikely that there has been an opportunity for confusion to occur.

Finally, regarding applicant's statement that "identical marks have been held not likely to be confused," we note that we must decide this case on the record before us and the facts in this case warrant the conclusion that confusion is likely.

Decision: The refusal to register under Section 2(d) of the Trademark Act is affirmed.